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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,981	02/16/2001	Francoise Leclercq	03806.0500	2816

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EXAMINER

EPPS FORD, JANET L

ART UNIT

PAPER NUMBER

1635

DATE MAILED: 09/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/783,981

Applicant(s)

LECLERCQ ET AL.

Examiner

Janet L. Epps-Ford, Ph.D.

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

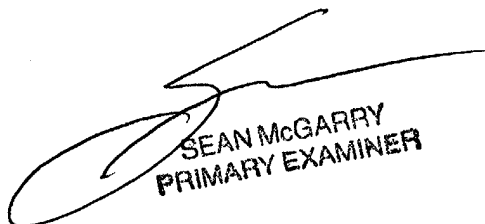
Claim(s) rejected: 29-33 for the reasons of record.Claim(s) withdrawn from consideration: 39-42 for the reasons of record.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

Continuation of 3.

Continuation of 10. Other: Applicant's arguments filed 8-12-03 have been fully considered but they are not persuasive. Applicants traverse the rejection of claims 34-38 on the grounds that "the specification as filed clearly informed the skilled artisan that the targeting elements are moieties that direct (i.e. target) the transfer of functionalized polyalkeneimine-nucleic acid complexes toward desired cell types..." However, the features upon which Applicant relies, as recited in the specification as filed on page 6, lines 25-28, are not recited in the instant claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. Moreover, the specification as filed merely defines the targeting element in terms of its function, there is no structure defined in the specification as filed associated with said targeting element.

In regards to the rejection of claims 23-33, Applicants argue that the cited references fail to teach or suggest all the claim elements when taken alone or together. Moreover, Applicants argue that the cited references fail to provide a reasonable expectation of success (e.g., use of Neidigh's method to prepare molecules capable of mediating gene delivery to cells.) Contrary to Applicant's assertions, the instantly examined claims do not recite that the process for making functionalized polyalkyleneimines produce molecules that are capable of mediating gene delivery to cells. The features upon which Applicant's rely upon for their arguments are not limitations recited in the instantly examined claims. Moreover, Applicant's arguments do not take the place of evidence that the process for preparing functionalized polyalkyleneimines as taught by the combination of the Zanta et al. and Neidigh et al. references would not be expected to produce compounds having the same functional characteristics as the compounds produced by the methods recited in the currently examined claims.



SEAN MCGARRY
PRIMARY EXAMINER